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In re Application of :
LABRIE, Craig B et al :
U.S. Application No.: 09/786,305 :
PCT No.: PCT/US99/13592 :
Int. Filing Date: 16 June 1999 :
Priority Date: 19 June 1998 :
Attorney Docket No.: TRM DV2539 :
For: APPARATUS FOR DEPLOYING AN :
AIR BAG . . . :
:

**DECISION ON SECOND
RENEWED PETITION
UNDER 37 CFR 1.47(a)**

This decision is in response to applicants' "Renewed Petition Under 37 CFR 1.47(a)" ("Ren.Pet.") submitted 05 August 2002.

BACKGROUND

On 05 June 2002, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed.

On 06 May 2002, applicants filed the instant renewed petition which was accompanied by copies of an internet search for a "John Kennedy" in Michigan.

DISCUSSION

The 05 June 2002 decision dismissed applicants' petition filed 06 May 2002 for failing to submit a detailed statement of facts showing all the steps used to locate the nonsigning inventors.

In this renewed petition, applicants argue that they "have exhausted all available steps to obtain Mr. Daniels' signature. Mr. Daniels refused to sign when asked. Mr. Daniels elected to move and not provide the public with any forwarding contact information." Ren.Pet. at ¶ 5. Concerning Mr. Kennedy, applicants maintain that "John J. Kennedy is no longer in the employment of the assignee of the application, Textron Automotive Company. Mr. Kennedy (???) forwarded a copy of the application to the last known address that Mr. Kennedy provided to Textron. Mr. Kennedy nonetheless elected to move from this address, and also elected NOT to provide any forwarding information whatsoever." *Id.* at ¶ 7. Applicants then allege that they performed an internet search for a John Kennedy in the state of Michigan and came up with 87 hits which they did not follow up on.

The evidence provided is not sufficient to meet the requirements of the 37 CFR 1.47(a).

An inventor on behalf of themselves and the nonsigning inventors may make an application for patent under 37 CFR 1.47(a) only if a joint inventor refuses to sign or cannot be found or reached after a diligent effort was made to locate the nonsigning inventor. Here, applicants claim that both Mr. Daniels and Mr. Kennedy cannot be found. (Applicants initially claimed that Mr. Daniels refused to sign. However, before meeting the requirements to prove a refusal, applicants then claimed that Mr. Daniels could not be located.)

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) discusses the situation when a joint inventor cannot be located to provide guidance to applicants and states:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included (in a) statement of facts. It is important that the statement contain facts as opposed to conclusions.

What constitutes a "diligent effort" to locate a nonsigning inventor various from case to case. Nonetheless, it is clear from the MPEP that this provision is not to be used in situations where the joint inventor is temporarily incapacitated, or on an extended vacation. A detailed description of the facts used by applicants to conclude

that the nonsigning joint inventors cannot be located must also be provided to ensure that this decision was reached only after appropriate steps were taken with the required diligence by applicants to safeguard the nonsigning inventor's rights. This statement should be signed by a person who has direct firsthand knowledge of the facts unless there is a compelling reason for the Office to accept such a statement by a person who does not have the requisite direct knowledge.

This section of the MPEP also provides guidance to applicants to help them meet the "diligent effort" requirement which may or may not be applicable depending upon the circumstances. Internet searches, certified mail return receipts, cover letters of instructions, telegrams are specifically listed but as applicants suggest in the renewed petition, they may or may not be applicable.

In the renewed petition, applicants still have not shown that a diligent effort was made to contact either of the two nonsigning joint inventors. There is no indication that applicants attempted to contact the former employer or co-workers of the nonsigning inventors to see if any additional information on their whereabouts could be determined. There is also no showing that the other joint inventors of the above-captioned application were questioned about the whereabouts of the nonsigning inventors. If any of these things were accomplished, they were not described on a statement of facts signed by a person having direct knowledge of this as required by the MPEP.

Moreover, applicants claim that the telephone was used to seek and obtain Mr. Daniels' signature. Id. at ¶ 4. The claim for Mr. Daniels is that he cannot be located, therefore, applicants must satisfy the requirements needed to prove this. Applicants claim that Mr. Daniels allegedly refused to cooperate is not pertinent to applicants claim that Mr. Daniels cannot be located. Applicants failed to satisfy the requirements of a refusal as discussed in the decision dated 06 February 2002. In trying to satisfy the requirements needed to prove a refusal, applicants claim that they are unable because Mr. Daniel's cannot be found. Applicants need to show that they attempted to contact Mr. Daniel's using the telephone after learning that he cannot be located.

Finally, a review of the international publication ("WO 99/65738") for PCT/US99/13592 lists the name of one of the nonsigning inventors as Jack J. Kennedy, not John J. Kennedy as applicants record him on the declaration and the instant petition. A review of the international application did not show that a PCT Rule 92bis change of the name of the applicant/inventor was made in the international application. The International Bureau also does not have a record of such a change. If the international publication is incorrect, a petition under 37 CFR 1.181 may be appropriate. If, on the other hand, Mr. Kennedy changed his name from Jack to John, a petition under 37 CFR 1.182 is required.

CONCLUSION

For the reasons discussed above, applicants' renewed petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

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